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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,774

04/22/2005

Gerd Hohner

2002DE140

7075

25255 7590 06/29/2007

CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

RODEE, CHRISTOPHER D

ART UNIT

PAPER NUMBER

1756

MAIL DATE

DELIVERY MODE

06/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,774

Applicant(s)

HOHNER ET AL.

Examiner

Christopher RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/29/06</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION***Specification***

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

The foreign publication discussed on specification page 2, line 28 – page 3, line 2 is essential subject matter because it defines the meaning of “wax” as used in the instant specification. Because a specific definition of “wax” is presented it limits the claims because a “wax” is required. The Examiner notes that certain properties of wax are recited in the above noted passage but it is unclear if the foreign publication includes or excludes other attributes than those recited. Additionally, certain DIN standards are used to determine the needle penetration values (p. 4, l. 21-22). This characteristic is present in the claims and, as a result, the manner of measurement is essential subject matter for these claims. Applicants are required to amend the specification as discussed above to include the essential matter. See MPEP 608.01(p) and 37 CFR 1.57(c) and (e).

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The abstract of the disclosure is objected to because the abstract does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 and 9-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Instant claims 1-4 have been amended and new claims 9-14 submitted. These claims state that erucamide and at least one wax are added to the toner. A toner as it would be understood by one of skill in the art refers to a powder material that typically contains a resin, colorant, and other materials. This is consistent with the use of the term "toner" in the specification (e.g., see Examples). The claims as presented require the erucamide to be added to the toner; that is to the powder. The specification as filed does not describe such an invention. The specification does disclose specific embodiments using specific steps where the erucamide and wax are blended with the other materials to form a toner, but there is no disclosure of adding the erucamide and wax to the toner particles.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Quan in US Patent 4,643,960.

See Examples 8 and 10 where a toner comprises a wax and erucamide. Disclosed waxes include castor wax and ouricury wax. Castor wax appears to meet the requirements of a partially synthetic wax because it is produced by hydrogenation of castor oil, a naturally occurring oil. The preferred wax melting temperature is 65 °C to 125 °C (col. 3, l. 51-55), and, as a result of this disclosure, there is sufficient reason to believe that the waxes in the examples inherently have a melting point within the range of the dependent claims (e.g., claims 4 and 8) as well as the needle penetration (e.g., claims 3 and 7). Mixing the toner prespheres together with the wax and erucamide produces the toners.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamano *et al.* in US Patent 6,500,594 in view of JP 06-180511.

Hamano discloses a toner containing a sulfopolyester binder resin (col. 4, l. 49 – col. 5, l. 45; Examples I & II), a coloring agent in an amount of from 0.1 to 40 parts by weight, preferably 1 to 30 parts by weight (col. 7, l. 52 – col. 8, l. 15), and a release agent, such as an aliphatic acid amide, such as erucic amide (col. 8, l. 54-59). The releasing agent is present in an amount of from 1 to 20 parts by weight, preferably 2 to 15 parts by weight, based on 100 parts of the toner components (col. 9, l. 1-4), and may be used single or as a combination of two or more.

Hamano does not disclose the releasing agent combination of the claims. However, the JP document teaches that acid amide releasing agents are effective to prevent offset and winding of paper at the time of fixing while also minimizing deterioration of flowability and transferability. The acid amide releasing agents have the formula $R_1\text{-CONH-R}_2$ where R_1 and R_2 are 9 to 21 carbon atom alkyl chains. Various alkyl acid amide releasing agents are disclosed in the JP document, including stearyl erucamide (¶ [0009]). As discussed in the JP document, these alkyl acid amides are effective with various binder resins, including polyesters (¶ [0010]).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the alkyl acid amide of the JP document as one of the releasing agent in the Hamano because Hamano calls for acid amide releasing agents and the JP document discloses such a compound that not only has reduced offset but also minimizes deterioration of flowability and transferability during copying. Further, the artisan would have found it obvious to use the erucamide with another releasing agent disclosed because Hamano teaches that combinations of the releasing agents are effectively employed and the artisan

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would have chosen another wax from this list, such as carnauba wax (note Table 1 in the instant specification for properties of this wax), in order to improve the release properties of the toner.

Double Patenting

Applicant is advised that should claims 1 and 9 be found allowable, claims 11 and 12 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The recitation of "improving release properties of a toner composition" in claim 1 and the recitation of "using a combination" in claim 11 do not differentiate the claims because these are intended uses and results of the toner. Because the process steps are the same, the claims duplicate the same subject matter within their scopes of protection.

Applicant is advised that should claim 10 be found allowable, claim 14 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The instant claims recite a product toner produced by a recited process. Because the processes are the same, as noted immediately above, the products must also be the same.

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on Monday to Thursday from 5:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher RoDee/
Primary Examiner
Art Unit 1756

cdr
24 June 2007